REMARKS

The Office Action dated August 5, 2008 has been received and carefully noted. The above amendments to the claims, and the following remarks, are submitted as a full and complete response thereto.

Claims 1, 11, 17, 18 and 34-41 have been amended to more particularly point out and distinctly claim the subject matter of the invention. No new matter has been added. Claims 1-41 are presently pending.

Initially, Applicants wish to thank the Examiner for the time and courtesy extended during the telephonic interview of November 18, 2008. However, Applicants submit that all currently pending claims 1-41 are allowable over any outstanding rejections for at least the following reasons.

The Office Action rejected claims 38 and 39 under §101 for allegedly being directed to non-statutory subject matter. The rejection alleged that the computer readable medium is not defined in the specification. The rejection also alleged that claims 38 and 39 will be considered non-statutory subject matter absent support in the specification. This rejection is respectfully traversed.

What is disclosed in the specification has no bearing on patentability under the statutory classes of invention governed by 35 U.S.C. §101. Furthermore, "A computer readable medium" is statutory subject matter under U.S. patent laws. Support for the definition of a computer readable medium is provided by *In re Lowry*, 32 F.3d 1579, 1583-1854, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994), which states:

> "When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized" (see §2106.01 of the MPEP).

As can be clearly observed from the court's decision in *Lowry* a computer readable medium is statutory subject matter under §101. By having software recorded on a computer readable medium, it becomes structural and functional with respect to that medium, and, thus, statutory subject matter. Withdrawal of the rejection is kindly requested.

In the Office Action, claims 38 and 39 were rejected under §112, first paragraph, because the computer readable medium is not defined in the specification and is, thus, non-statutory subject matter absent support in the specification. This rejection is respectfully traversed. Referring the Examiner to FIG. 4 of the present application, a process is illustrated which defines a new event package for event registrations of a user to be implemented by a registrar and used by a presence server 303. The user may be a computer terminal 123 or laptop 112 which may include a computer readable medium (see lines 23-33 of page 7 of the specification). A computer readable medium may be regarded as a computer memory which a computer terminal 123 or laptop 112 is certain to include. Or, one of ordinary skill in the art is certain to conclude that a computer terminal 123 or laptop 112 includes a computer readable medium in order to carry out the functions of such a computing device.

As for the presence server 303, the presence server interfaces with the shared resource 204 which provides storage for the presence information (see last 3 lines of page 9 of the specification). The presence server 303 also may be a computer readable medium because it also has a memory. Among the various operations performed in claims 38 and 39, each of these operations is performed with reference to the computer readable mediums provided by the presence server and/or the user. Therefore, the specification provides support for a computer readable medium, and claims 38 and 39 are in compliance with §112, first paragraph. Withdrawal of the rejection is kindly requested.

Claims 1-7, 11-30 and 34-41 were rejected under 35 U.S.C. §103(a) as being unpatentable over Bobde (U.S. Patent Publication No. 2003/0217142) in view of Wang (U.S. Patent Publication No. 2002/0131395). The Office Action took the position that Bobde discloses all of the elements of the claims, with the exception of sending a notification from a first network element to a second network element in response to the register message. The Office Action then cited Wang as allegedly curing this deficiency in Bobde. This rejection is respectfully traversed for at least the following reasons.

Claim 1, upon which claims 2-10 are dependent, recites a method that includes maintaining, in a first network element of a communication system, registration information from a plurality of users. The method also includes maintaining, in a second network element of the communication system, information associated with said plurality of users. The second network element information comprising a record of registration

information that is separate from the registration maintained in the first network element. The second network element is separate from the first network element. The second network element information is dependent on the registration information. The method also includes sending a subscribe message for an event from the second network element to the first network element. The event is a change in the registration information of at least one of the plurality of users at the first network element. The method also includes receiving at the first network element a register message from at least one user, the message changing the registration information of said at least one user. The method also includes sending a notification from the first network element to the second network element in response to the register message. The notification includes information associated with said at least one user. The information associated with said at least one user comprising registration status information of a network device operated by said user.

Claim 11, upon which claims 12-16 are dependent, recites a system that includes a first network element configured to maintain registration information from a plurality of users. The system also includes a second network element configured to maintain information associated with the plurality of users. The second network element information comprising a record of registration information that is separate from the registration maintained in the first network element. The second network element is separate from the first network element. The second network element information is dependent on the registration information. The second network element is configured to send a subscribe message for an event to the first network element. The first network

element is configured to receive a register message from at least one user, said register message configured to change the registration information of said at least one user. The event is associated with a change in the registration information of at least one of the plurality of users at the first network element. The first network element is configured to send a notification from the first network element to the second network element in response to the register message. The notification includes information associated with said at least one user. The information associated with said at least one user comprising registration status information of a network device operated by said user.

Claim 17, upon which claims 19-23 are dependent, recites an apparatus that includes storage circuitry configured to maintain registration information from a plurality of users. The apparatus also includes receiving circuitry configured to receive a subscribe message for an event from a network element. The network element maintaining information comprising a record of registration information that is separate from the registration maintained in the apparatus and said network element information is dependent on the registration information. The network element is separate from the apparatus and the event is associated with a change in the registration information of at least one of the plurality of users at the apparatus. The apparatus also includes receiving circuitry configured to receive a register message from at least one user. The register message configured to change the registration information of said at least one user. The apparatus also includes transmitting circuitry configured to send a notification to the network element in response to the register message. The notification includes

information associated with said at least one user, the information associated with the at least one user comprising registration status information of a network device operated by said user.

Claim 18, upon which claims 25-33 are dependent, recites an apparatus that includes storage circuitry configured to maintain information associated with a plurality of users. The information is dependent on registration information maintained at a network element. The network element is separate from the apparatus. The apparatus also includes transmitting circuitry configured to send a subscribe message for an event to the network element. The network element maintaining information comprising a record of registration information that is separate from the registration maintained in the apparatus and the network element information is dependent on the registration information. The event is associated with a change in the registration information of at least one of the plurality of users at the network element. The apparatus also includes receiving circuitry configured to receive a notification from the network element. The notification includes information associated with the at least one user. The information associated with the at least one user comprising registration status information of a network device operated by said user.

Claim 34 recites a method that includes maintaining, in a registrar server network element of a communication system, registration information from a plurality of users. The method also includes maintaining, in a presence server network element of the communication system separate from the registrar server network element, information

associated with said plurality of users. The presence network element information comprising a record of registration information that is separate from the registration maintained in the registrar network element wherein the presence server network element information is dependent on the registration information. The method also includes sending a subscribe message for an event from the presence server network element to the registrar server network element. The event is a change in the registration information of at least one of the plurality of users at the registrar server network element. The method also includes receiving at the registrar server network element a register message from at least one user, the message changing the registration information of said at least one user. The method also includes sending a notification from the registrar server network element to the presence server network element in response to the register message. The notification includes information associated with the at least one user. The information associated with the at least one user comprising registration status information of a network device operated by said user.

Claim 35 recites a system that includes a registrar server network element configured to maintain registration information from a plurality of users. The system also includes a presence server network element configured to maintain information associated with said plurality of users. The presence network element information comprising a record of registration information that is separate from the registration maintained in the registrar network element. The presence server network element is separate from the registrar service network element and the presence server network

element information is dependent on the registration information. The presence server network element is configured to send a subscribe message for an event to the registrar server network element. The registrar server network element is configured to receive a register message from at least one user, said register message configured to change the registration information of said at least one user. The event is associated with a change in the registration information of at least one of the plurality of users at the registrar server network element. The registrar server network element is configured to send a notification from the registrar server network element to the presence server network element in response to the register message. The notification includes information associated with the at least one user. The information associated with the at least one user comprising registration status information of a network device operated by the user.

Claim 36 recites an apparatus that includes storage circuitry configured to maintain registration information from a plurality of users. The apparatus also includes receiving circuitry configured to receive a subscribe message for an event from a presence server network element. The presence server network element maintaining information comprising a record of registration information that is separate from the registration maintained in the apparatus. The network element information is dependent on the registration information. The presence server network element is separate from the apparatus. The event is associated with a change in the registration information of at least one of the plurality of users at the apparatus. The apparatus also includes receiving circuitry configured to receive a register message from at least one user. The register

message configured to change the registration information of the at least one user. The transmitting circuitry is configured to send a notification to the presence server network element in response to the register message. The notification includes information associated with the at least one user. The information associated with the at least one user including registration status information of a network device operated by said user.

Claim 37 recites an apparatus that includes storage circuitry configured to maintain information associated with a plurality of users. The information is dependent on registration information maintained at a registrar server network element. The registrar server network element is separate from the apparatus. The apparatus also includes transmitting circuitry configured to send a subscribe message for an event to the registrar server network element. The presence server network element maintaining information comprising a record of registration information that is separate from the registration maintained in the apparatus and the network element information is dependent on the registration information. The event is associated with a change in the registration information of at least one of the plurality of users at the registrar server network element. The apparatus also includes receiving circuitry configured to receive a notification from the registrar server network element. The notification includes information associated with the at least one user. The information associated with the at least one user including registration status information of a network device operated by the user.

Claims 38 and 39 recite computer program type claims that are similar to the operations of the above-noted method claims. Claims 40 and 41 are means-plus-function claims that are similar to the elements recited in the above-noted apparatus claims.

As will be discussed below, the combination of Bobde and Wang fails to disclose or suggest all of the elements of the claims, and therefore fails to provide the features discussed above. The rejection is respectfully traversed for at least the following reasons.

Applicants proceed by pointing to the previous Office Action mailed on February 5, 2008. On page 7, line 7 of that Office Action, it was admitted that Bobde and Wang do not disclose each of the features recited in the independent claims. The Office Action then relied upon the disclosure of Requena as allegedly curing the deficiencies of Bobde and Wang with respect to features recited in the independent claims. After this Office Action was mailed, Applicants responded by having Requena disqualified as prior art under the §103(c) exception.

Regardless of the admitted deficiencies of Bobde and Wang with respect to the claims, the present Office Action now only relied on Bobde and Wang as allegedly disclosing all of the operations in the pending claims. The reasoning behind the allegation that Bobde and Wang disclose all of the subject matter of the pending claims is supplemented by a statement that "examiner takes note that it is not explicitly disclosed in paragraph [0028] but it is stated that one of the tasks of the presence agent (152) is to "generate notifications of changes" which would inherently be sent or queried to the "registrar" since that is where the user registration resides" (see page 4, last 5 lines of

page 4 of the Office Action). Applicants disagree and submit that Bobde, Wang and what is allegedly considered inherent by the Office Action fail to establish a prima facie case of obviousness with respect to any of the pending claims.

Bobde generally relates to a method and system for supporting the communication of presence information regarding one or more telephony devices. More specifically, Bobde discusses a system for detecting and communicating the presence of one or more computing devices. Bobde also discusses a method and system for aggregating presence information generated by multiple devices associated with a single user. Bobde describes a single server acting as a presence agent and a registration agent.

Bobde also discloses a single server 102 acting as both a presence agent and a registration agent. Referring to FIG. 3 of Bobde, the server 102 includes a registration program 154 and a presence agent 152 as part of the server 102. In other words, Bobde describes a single network element (i.e., server 102) upon which a first presence application can be run and a second registration agent can also be run. Both agents have access to the same information source of the server 102.

Bobde fails to disclose "maintaining, in a first network element...registration information from a plurality of users...maintaining, in a second network element...information associated with said plurality of users, said second network element information comprising a record of registration information that is separate from the registration maintained in the first network element, wherein the second network element is separate from the first network element...and...said information associated

with said at least one user comprising registration status information of a network device operated by said user", as recited, in part, in independent claim 1 and similarly in independent claims 11, 17, 18 and 34-41 (emphasis added).

The independent claims each recite two separate network elements (e.g., a first network element and a second network element, or, a presence server and a registrar server). The claims also recite that there are two "separate" pieces of registration information. Bobde illustrates a single registration application "R" used by the entire server 102. Although, in Bobde, the presence agent 152 is illustrated as being in direct communication with the registration application 154, whatever registration information is used by the presence agent 152 or any other part of the server 102, that information is certainly only stored in the registration application 154. In other words, there is no second "separate" registration information provided anywhere.

In addition to the above-noted deficiencies of Bobde, the type of system illustrated in Bobde is similar to the type of system that is disclosed in the specification as being prior art (see FIG. 2 of the present application). Referring to FIG. 2, the single network entity 206 includes a registrar 203 and a presence server 205 in the same network element. FIG. 3 of the present application illustrates two separate network entities 301 and 303, which include the registrar 302 and the presence server 304. The independent claims have been amended to more clearly recite that there are two separate network entities similar to FIG. 3. Bobde does not disclose two separate network entities that both keep records of registration related information.

Wang fails to remedy the above-identified deficiencies of Bobde. Wang generally relates to a session initiation protocol (SIP) user agent in a serving GPRS support node (SGSN). More specifically, Wang discloses that a SIP application service can be connected to an SGSN by a SIP user agent. Wang discusses, in FIG. 12 for example, that a mobile station can register itself to a first presence server (216), which, in turn, forwards any changes in registration to the home presence server (1206). The two presence servers, however, are operated in such a way that the presence server that is visited only passes information directly to the home presence server that then fields any request from a watching agent.

Wang fails to disclose sending a subscribed message for an event from the home presence server to the visited server wherein the event is a change in the registration information. The communications disclosed in paragraph [0080] of Wang include a users A and B communicating back and forth, and a presence server 126 belonging to user A's home network. In operation, user B subscribes to user A's presence status by contacting user A's home presence server. There is no indication of any registration information being stored at two separate network elements.

Similar to the deficiencies in Bobde, Wang also fails to disclose "maintaining, in a first network element...registration information from a plurality of users...maintaining, in a second network element...information associated with said plurality of users, said second network element information comprising a record of registration information that is separate from the registration maintained in the first network element, wherein the

second network element is separate from the first network element...and...said information associated with said at least one user comprising registration status information of a network device operated by said user", as recited, in part, in independent claim 1 and similarly in independent claims 11, 17, 18 and 34-41.

Therefore, Applicants submit that Bobde and Wang, taken individually or in combination fail to disclose all of the subject matter of independent claims 1, 11, 17, 18 and 34-41. By virtue of dependency, Bobde and Wang also fails to teach the subject matter of those claims dependent thereon. Withdrawal of the rejection of claims 1-7, 11-30 and 34-41 is kindly requested.

Claims 8-9 and 31-32 were rejected under 35 U.S.C. 103(a) as being unpatentable over Bobde in view of Wang, and further in view of "IMPS – Instant Messaging and Presence using SIP" of Donovan ("Donovan"). The Office Action took the position that the combination of Bobde and Wang discloses all of the features of the claims except "wherein a third entity sends a subscribe message to the second entity for information associated with said at least one user. Applicants respectfully traverse this rejection.

Claims 8-9 and 31-32 depend respectively from, and further limit, claims 1 and 18. At least some of the deficiencies of Bobde and Wang with respect to claims 1 and 18 are discussed above. Donovan does not remedy the above-discussed deficiencies of Bobde and Wang, and, thus, the combination of Bobde, Wang, and Donovan fails to disclose or suggest all of the elements of any of the presently pending claims.

Donovan generally relates to Instant Messaging and Presence using SIP (IMPS), and was not cited with regard to the above-discussed features with respect to which the combination of Bobde and Wang is deficient. Donovan fails to remedy the above-identified deficiencies of Bobde and Wang. Accordingly, it is respectfully submitted that the combination of Bobde, Wang, and Donovan fails to disclose or suggest all of the elements of claims 8-9 and 31-32, and withdrawal of the rejection is respectfully requested.

Claims 10 and 33 were listed as being rejected under 35 U.S.C. 103(a) as being unpatentable over Bobde in view of Wang; however, claims 10 and 33 depend respectively from claims 8 and 31 (with respect to which the combination of Bobde and Wang is admittedly deficient according to the rejection of claims 8 and 31). Thus, this rejection is improper on its face because this combination of references was addressed in its entirety above. It is, accordingly, respectfully requested that the rejection of claims 10 and 33 be withdrawn.

For the reasons set forth above, it is respectfully submitted that each of claims 1-37 recites subject matter that is neither disclosed nor suggested in the cited art. It is, therefore, respectfully requested that all of claims 1-44 be allowed, and that this application be passed to issuance.

If for any reason the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact, by

telephone, the applicants' undersigned representative at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

In the event this paper is not being timely filed, the applicants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,

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